

REMARKS

The above-identified Office Action dated March 29, 2004 contained a final rejection of claims 1-34. Claims 1-3, 9, 18 and 27 have been amended, **not** in response to the rejections based on the cited references, but in an effort to **clarify the invention**. The limitations added to the independent claims were previously included in some of the original dependent claims. Therefore, the Applicant submits that a new search will **not** be required by the Examiner. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Therefore, it is respectfully requested that the amendments to claims 1 and 18 be entered despite the finality of the present rejection.

The Office Action rejected claims 1, 7, 9, 16, 18, 25, 27 and 33 under 35 U.S.C. 102(e) as allegedly being anticipated by Zimmerman et al. (U.S. Patent No. 6,678,694).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

Claims 1, 9, 18 and 27 recite in part a system, method or computer readable medium "...for efficient information storage and retrieval of information..." that includes "...capturing with a scanner a selected portion of text of printed information...and recommending topic matters based on keys of previously scanned text of printed information and previously stored electronic information that are related to the printed information being captured during retrieval of the printed information..."

In contrast, Zimmerman et al. simply disclose "...Internet or intranet based document retrieval system..." for retrieving electronic documents and do **not** disclose capturing printed documents with a scanner. Also, although Zimmerman et al. disclose displaying "suggested topics" after a search is performed by a user (see col 4. , lines 26-38), Zimmerman et al. fail to teach, suggest or disclose the Applicant's recommending topic matters based on keys of previously scanned text of printed information and previously stored electronic information. Thus, since Zimmerman et al. do **not** disclose all of the Applicant's features of either claims 1, 9, 18 or 27, Zimmerman et al. cannot anticipate either claim. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131.

The Office Action rejected claims 1-34 under 35 U.S.C. 103(a) as allegedly being unpatentable over Melen et al. (U.S. Patent No. 6,263,121) in view of Zimmerman et al. (U.S. Patent No. 6,678,694).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

According to case law and the MPEP, all of the claimed elements of an Applicant's invention **must be considered**. (*In re Kotzab*, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP* 2143.). If **one** of the elements of the Applicant's invention is **missing** from or not taught in the cited references and the Applicant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP* 2143.03). The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Specifically, Melen et al. merely discloses a "[S]ystem and method for archiving and retrieving documents based on attributes of the document..." Although Melen et al. disclose using a scanning device to capture a paper document, and Zimmerman et al. disclose displaying "suggested topics" after a search is performed by a user, the combination of these references still **fail** to disclose, teach or suggest the Applicant's claimed limitations of "...**capturing with a scanner a selected portion of text of printed information...and recommending topic matters based on keys of previously scanned text of printed information** and **previously stored electronic information** that are related to the printed information..." Therefore, because the cited reference, in combination or alone, do not disclose, teach or suggest the limitations of the claims, as discussed above, they cannot render the Applicant's claims obvious, and thus, this rejection should be withdrawn. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (*MPEP* § 2143.03).

As the foregoing amendments to the specification do not raise new issues, it is the

Applicants position that they are entitled to have the changes entered to place this case in condition for allowance, or alternately, in better condition for consideration on appeal under 37 CFR 1.116. It is, therefore, respectfully requested that the changes to the claims be entered despite the finality of the present rejection.

Thus, it is respectfully requested that claims 1-34 be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-34 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

Respectfully submitted,
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Edmond A. DeFrank
Reg. No. 37,814
Attorney for Applicants
(818) 885-1575 TEL
(818) 885-5750 FAX